



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,679	12/19/2000	J. Stuart Cumming	P02087US1	6074

34313 7590 04/02/2007
ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
----------	--------------

3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

ED

Office Action Summary	Application No. 09/740,679	Applicant(s) CUMMING, J. STUART	
	Examiner Paul B. Prebilic	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-124 is/are pending in the application.
 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-57, 59, 61, 63, 72-74, 77, 80, 85, 86, 90, 91, 93-95, 99-102 and 104-124 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 58,60,62,64-71,75,76,78,79,81-84,87-89,92 and 96-98.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 1, 2007 has been entered.

Election/Restrictions

Claims 58, 60, 62, 64-71, 75, 76, 78, 79, 81-84, 87-89, 92, and 96-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 11, 2002. Claim 65 is dependent upon a withdrawn base claim so it is withdrawn even though the Applicant argued that it was drawn to the elected invention.

Claim Objections

Claims 53, 90, 105, 106, 107, and 112 are objected to because of the following informalities:

In claim 53, on line 11, claim 90, on line 11, claim 105, on line 6, claim 106, on line 6, claim 107, on line 10 and claim 112, on line 6, the term "radaii" appears to be a misspelling for "radii." It has been interpreted as having that meaning.

With regard to claim 90, lines 15-16, claim 105, lines 10-16, and claim 106, lines 10-16, the language "wherein wherein" is considered redundant and grammatically awkward. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 53-57, 59, 61, 63, 72-74, 77, 90, 91, 93-95, 99-102, and 104-124 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new subject matter of "front and back radaii (sic) being essentially the same" lacks original support and constitutes new matter because continuing prosecution under 37 CFR 1.114 does not allow the introduction of new matter even if filed at the date of the RCE. The Examiner has reviewed the specification and could not find support for this limitation and notes that symmetry can be along the optical axis or plane and is not necessarily transverse to the optical axis.

As an alternative to the rejection of the previous paragraph and to address the situation that there is some inherent or implicit support for radii being essentially the same, the Examiner objects to the specification as at least failing to give proper antecedent basis to the claimed invention. The specification is objected to as failing to

Art Unit: 3738

provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 80 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18 of copending Application No. 11/297,233. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claim is read on by the present claim such that it is considered to be clearly obvious in view thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 80 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 52 and 78 of copending Application No. 10/977,233. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims are read on by the present claim such that they are considered to be clearly obvious in view thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 80 and 86 are rejected under 35 U.S.C. 102(b) as being anticipated by Tennant (US 4,254,510). Tennant anticipates the claim language where the plate haptics as claimed are the limbs (21,22) of Tennant; see Figures 1 to 5. The hinge as claimed is in the soft limbs; see column 3, line 60 et seq. The lens body can be inserted into a capsular bag; see column 2, line 55 et seq.

With regard to claim 86, since the Tennant device can inherently be used in the manner claimed, although not preferred, the Examiner asserts that the claim language is fully met.

Claims 80, 85, and 86 are rejected under 35 U.S.C. 102(b) as anticipated by Schlegel (US 4,454,597). Schlegel anticipates the claim language where the lens and

Art Unit: 3738

haptic structure is made entirely out of flexible silicone and it is inherently capable of accommodating due to flexing at the haptics to the extent required by the claim language; see Figures 3 and 4 as well as column 3, lines 17-30 and column 4, line 24 to column 5, line 17. The fact that stiffeners can or may be added to increase rigidity indicates that the haptics are inherently quite flexible without this optional feature. Furthermore, the holes are added to the haptics to make them even more flexible as desired; see column 4, lines 38-45. The Examiner considers one haptic being the section or area of the haptic ring between the holes (15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 53-57, 59, 61, 63, 72-74, 77, 90, 91, 93-95, 99, 100, 102, and 105-124 are rejected under 35 U.S.C. 102(b) as anticipated by Schlegal (US 4,454,597) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schlegal (US 4,424,597) in view of Tennant (US 4,254,510) or Tennant (US 4,254,509) and further view of Liebermann (US 5,512,039) or Wiley (US 5,066,301). Schlegal anticipates the claim language where the lens and haptic structure is made entirely out of flexible silicone and it is inherently capable of accommodating due to flexing at the haptics to the extent required by the claim language; see Figures 3 and 4 as well as column 3, lines 17-30 and column 4, line 24 to column 5, line 17. The fact that stiffeners can or may be added to

Art Unit: 3738

increase rigidity indicates that the haptics are inherently quite flexible without this optional feature. Furthermore, the holes are added to the haptics to make them even more flexible as desired; see column 4, lines 38-45. The Examiner considers one haptic being the section or area of the haptic ring between the holes (15). Furthermore, Schlegel discloses that the biconvex lenses can have front surface to back surface radius ratios of between 1.5 to 3.0 (see claims 10 and 11 thereof). The Examiner asserts that a radius that is 1.5 times greater than another radius is "essentially the same" to the extent that this language can be given patentable weight.

Alternatively, one may not consider the claim language met by Schlegel because one could consider it outside the suggest scope. However, Liebermann (see column 1, lines 6-14) and Wiley (see column 1, lines 9-16) both teach that the natural lens of the eye is essentially symmetrically biconvex when comparing the front and back surfaces. Therefore, it is the Examiner's position that it would have been at least obvious to make the Schlegel radius ratio closer to 1.0 in order to imitate the shape of the natural lens such that as many variable in lens design can be eliminated as possible.

Additionally, one may not understand Schlegel in the manner the Examiner has interpreted it with respect to multiple haptics being disclosed. However, even if one does not interpret Schlegel as disclosing multiple haptics, Tennant ('509) and Tennant ('510) both teach that it was known to make plate haptics that only partially surround the optic; see the figures of each. For this reason, it would have been obvious to make the Schlegel invention the same way for the same reasons that Tennant ('509) or Tennant

Art Unit: 3738

('510) does the same or in order to save on material costs of making the lenses by reducing the lateral width of Schlegel's haptics.

With regard to claim 100, the knob as claimed is the ridge (17) of Schlegel.

With regard to claim 123, the groove as claimed is between the lens (11) and the ridge (23).

Claims 101 and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlegel (US 4,424,597), Tenant ('509), Tenant ('510), Liebermann, and Wiley as set forth in the rejection of claims 53-57, 59, 61, 63, 72-74, 77, 90, 91, 93-95, 99, 100, 102, and 104-124 in further view of a teaching found in Tennant (US 4,254,510).

Schlegel fails to disclose pairs of knobs for each haptic as claimed. However, Tennant ('510; see Figure 1 and elements 13a and 14a) teaches that pairs of knobs for each haptic were known. Therefore, it is the Examiner's position that it would have been obvious to form such features on the Schlegel device for stability of the implanted device and for the same reasons that Tennant ('510) utilizes the same.

Response to Arguments

Applicant's arguments filed March 1, 2007 have been fully considered but they are considered moot in view of the new grounds of rejection.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that

Art Unit: 3738

set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
Art Unit 3738